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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 10/750,810 | 12/31/2003 | Werner Holzl | HM/5-21810/A/PCT/DIV | 1623 |
| 324 | 7590 | 09/22/2005 | EXAMINER | |
| CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005 | | | BADIO, BARBARA P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1617 | |
| DATE MAILED: 09/22/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/750,810 | HOLZL ET AL. | |
| | Examiner Barbara P. Badio, Ph.D. | Art Unit 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 11-19 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 18 and 19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected-to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/22/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Final Office Action on the Merits

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of the Application

2. Claims 11-19 are pending in the present application. Claims 11-17 stand withdrawn from further consideration as being drawn to a nonelected invention. Claims 18 and 19 are rejected as indicated below.

Claim Rejections - 35 USC § 103

3. **The rejection of claims 18 and 19 under 35 USC 103(a) over Muehlbauer et al. (GB 1079348) and Kaminski et al. (US 4,115,588) or Lang et al. (US 4,772,689) or Blank (US 4,847,088) in combination is maintained.**

Applicant argues Muehlbauer et al. describes a preparation comprising a fungicidally active oxathiazol-2-one derivative that is formulated in acetone and there is no suggestion that the preparation could be used for application on human body. Applicant also argues that even if a skilled person were to combine the teachings of the cited prior art, he would not arrive at the present invention because the compounds taught by the secondary are not oxathiazol-2-one derivative and there is no teaching therein to motivate a skilled artisan to replace said compound with the presently claimed

compounds. Applicant's argument was considered but not persuasive for the following reasons.

The use of acetone in cosmetic compositions and as a fungicidally acceptable carrier is well known in the art (see for example, US 6,552,080, col. 15, lines 20-29; US 5,833,997, lines 45-50). The art also teaches various other solvents that are useful as both fungicidally acceptable carriers and in the preparation of cosmetic compositions (see references noted above). Thus, depending on the use of said personal care preparation, the replacement of one solvent with another would have been *prima facie* obvious to one skilled in the art at the time of the present invention.

Applicant also argues the secondary references do not provide motivation for the replacement of the antibacterial compounds taught therein with the presently claimed compounds. The examiner disagrees because (a) the cosmetic art teaches the use of antimicrobial to prevent contamination and deterioration of cosmetic products and (b) Muehlbauer teaches oxathiazol-2-one derivatives, including those of the instant claims, as antimicrobial agents. The skilled artisan in the art would be motivated to utilize the compounds taught by Muehlbauer in cosmetic product because he would have the reasonable expectation that the use of said compounds in cosmetic products would provide protection against contamination and deterioration.

For these reasons and those given in previous Office Action, the rejection of claims 18 and 19 under 35 USC 103(a) over Muehlbauer et al. (GB 1079348) and Kaminski et al. (US 4,115,588) or Lang et al. (US 4,772,689) or Blank (US 4,847,088) in combination is maintained.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Radio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Barbara P. Radio, Ph.D.
Primary Examiner
Art Unit 1617

BB

September 21, 2005